

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: SCHERZ=4

In re Application of:)	Conf. No.: 8697
)	
Avigdor SCHERZ et al)	Art Unit: 1624
)	
Appln. No.: 10/534,692)	Examiner: P. V. Ward
)	
Filed: November 9, 2005)	Washington, D.C.
)	
For: WATER-SOLUBLE ANIONIC)	October 6, 2008
BACTERIOCHLOROPHYLL)	
DERIVATIVES AND THEIR ...)	

RESPONSE

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

The present communication is responsive to the official action of August 6, 2008. Claims 1-50 presently appear in this case. The official action of August 6, 2008, in the nature of a restriction requirement, has now been carefully studied. Prompt consideration and allowance of all of the claims now present in the case are respectfully urged.

The examiner states that the application contains claims directed to the following patentably distinct species: metalloporphyrins, heteroaryls, and porphyrins. The examiner states that the species are independent or distinct because

Appln. No. 10/534,692
Response dated October 6, 2008
Reply to Office action of August 6, 2008

claims to the different species recite the mutually exclusive characteristics of such species and that these species are not obvious variants of one another on the current record.

Applicant has been required to elect a single disclosed species for prosecution on the merits to which the claims would be restricted if no generic claim is finally held to be allowable. The examiner states that upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species that depend from or otherwise require all of the limitations of an allowable generic claim.

The election requirement is confusing as the present claims relate to bacteriochlorophylls. Bacteriochlorophylls are derivatives porphyrins (see the definition at page 1, line 15 of the present specification). The bacteriochlorophylls of the present invention may or may not have a central metal atom, but it is not understood what the examiner means by "heteroaryls" as a separate species from "metalloporphyrins" and "porphyrins." Nor is it understood how "porphoryns" is a separate species from "metalloporphyrins" and "heteroaryls." It is possible for a single compound to be in all three categories. As the species are not mutually exclusive, it is difficult to comply with the species election requirement.

In a telephone conference with Examiner Ward on September 8, 2008, Examiner Ward stated that it would be

Appln. No. 10/534,692
Response dated October 6, 2008
Reply to Office action of August 6, 2008

sufficient to simply elect the most important single molecule as a species so that the examiner could begin his search.

Accordingly, applicant hereby elects, without traverse, the species of compound 4 (page 20, lines 1 and 2, and example 1). The claims encompassing the elected species are 1, 2, 4, 6, 7, 8, 12, 14, 15, 17-29, 36-41, 43 and 44, of which claims 1, 2, 6, 7, 14, 19, 20, 21, 26, 36, 38, 39 and 40 are generic claims.

It is requested that the examiner determine into which class of species the elected species falls and that the examiner advise applicants which claims the examiner considers to be withdrawn from consideration.

Once the elected species is found to be allowable it is understood that the examiner will examine all of the rest of the claims present in this case. Accordingly, prompt consideration on the merits and allowance of all the claims now present in the case are earnestly solicited.

Respectfully submitted,

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